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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,018	07/27/2000	Helmut Weber	70442.1201	9975

7590 12/21/2004

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New York, NY 10004

EXAMINER
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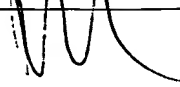
THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/627,018	<b>Applicant(s)</b> WEBER ET AL. 	
	<b>Examiner</b> Michael Thaler	<b>Art Unit</b> 3731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claimed "tip portion" should be clearly identified and described in the specification.

Claim 8 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Applicant's disclosure. The instrument shown in figures 1A-1D of the application is admitted as being prior art. This admitted prior art instrument is a convertible rongeur comprising front handle piece 106, bottom shaft piece 102 having tip portion (member 105 in combination with the distal portion of shaft piece 102 which is directly below gap 110) and handle portion 118, and a longitudinal axis from said handle portion to said tip portion, top shaft cutting piece 101 slideably engaged along said longitudinal axis with the tip portion (i.e. when the top shaft cutting piece 101 slides forwardly from the position shown in figure 1A so that it slides along the distal portion of shaft piece 102 which was directly below gap 110 but is now being covered by cutting piece 101), the top shaft cutting piece 101 being disengageable with the tip portion (when the top shaft cutting piece 101 is retracted to the position shown in figure 1A so that it no longer is directly above and engaged to the

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distal portion of shaft piece 102) wherein, when the top shaft cutting piece is disengaged from the tip portion, the top shaft cutting piece remains attached to the rongeur so as to retain all parts of the rongeur in one attached unit. Alternatively, it would have been obvious that the top shaft cutting piece 101 is disengageable with the tip portion since cutting piece 101 can be retracted to the position shown in figure 1A in which it is not above and does not contact the tip portion.

Claims 1-7 are allowed.

Applicant's arguments filed August 18, 2004 have been fully considered but they are not persuasive. It appears that the claimed "tip portion" of applicant's invention must be the unlabeled foot plate in combination with only the distal portion of shaft 202 since the longitudinal axis in claim 8, line 4-5 is defined as being from the handle portion 218 to the tip portion. The tip portion cannot be the entire bottom shaft 202 since the claimed longitudinal axis does not extend from the handle portion 218 to the entire bottom shaft 202. A similar portion of the admitted prior art device is considered to be the claimed "tip portion".

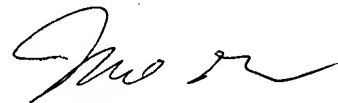
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

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Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht  
12/15/04



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731